



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,962	11/17/2000	Klaus Raming	Mo-5998/LeA-34.074	7971

157 7590 07/02/2002

BAYER CORPORATION
PATENT DEPARTMENT
100 BAYER ROAD
PITTSBURGH, PA 15205

EXAMINER

BRANNOCK, MICHAEL T

ART UNIT	PAPER NUMBER
----------	--------------

1646

DATE MAILED: 07/02/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/715,962

Applicant(s)
Ramling et al.

Examiner
Michael Brannock, Ph.D

Art Unit
1646



- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 12, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35 and 39-47 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35 and 39-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 6) ☐ Other: _____

Art Unit: 1646

DETAILED ACTION

Status of Application: Claims and Amendments

1. Applicant is notified that the amendments put forth in Paper 6, 4/12/02, have been entered in full.
2. Claims 35 and 39-47 are pending.
3. Applicant's election, with traverse in Paper 6, of SEQ ID NO: 2 is acknowledged. The traversal is on the grounds that the polypeptides of SEQ ID NO: 2, 4, and 6 are able to form heterodimers, therefore, Applicant believes those polypeptides are not patentably distinct. This argument has been fully considered but not deemed persuasive. Although the polypeptides can be used together, they do not have to be used together. Each structurally distinct polypeptide can be used in ways that are patentably distinct, e.g. to raise specific antibodies for immunohistochemical or other diagnostic procedures, or to purify the particular polypeptide- the use of one polypeptide not being required to use of any other, as further evidenced by the fact that the instant method claims do not require that the polypeptides be used together. Therefore, the restriction requirement is maintained and made final. Thus, Applicant is reminded that the instant claims are examined in this Office action only to the extent that they relate to the use of a polypeptide of SEQ ID NO: 2.

Art Unit: 1646

Claim Objections

4. Claims 35 and 39-44 are objected to as containing subject matter drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 35 and 39-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 requires the step of "determining the chemical specifically binding to said polypeptide". The word "determining" renders the claim indefinite for the following reasons. It is unclear how this step accomplishes the goal of "identifying a chemical" as recited in the preamble of the claim, because it is unclear what difference is intended by the presence of the word "determining" instead of "identifying". The artisan cannot determine what additional limitations are placed on the claim by the word "determining", and nor can the artisan know if goal recited in the preamble has been accomplished. Therefore the metes and bounds of the claim cannot be determined. It is suggested that substituting the word "identifying" for the word "determining" would obviate this rejection.

Art Unit: 1646

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 35 and 39-47 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for methods of identifying a chemical that specifically binds to a polypeptide having an the amino acid sequence of SEQ ID NO: 2, does not reasonably provide enablement for methods encompassing polypeptides having less than 100% identity to SEQ ID NO: 2. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The claims encompass methods of using a vast genus of polypeptide variants of the polypeptide of SEQ ID NO: 2, i.e. substitutions, deletions or insertions in a protein corresponding to SEQ ID NO: 2. Applicant has not provided sufficient guidance as to how to make and use the polypeptides which are not 100% identical to the polypeptide of SEQ ID NO: 2, but which still retain a desired property of the polypeptide of SEQ ID NO: 2. The vast majority of polypeptides encompassed by the claims are amino acid sequence variants of SEQ ID NO: 2, yet the specification has failed to teach one of skill in the art which amino acid substitutions, deletions or insertions to make. Furthermore, Applicant has not provided guidance as to what properties of the allelic variants or sequence variants of the protein corresponding to SEQ ID NO: 2 might be desired nor any guidance as to which amino acid substitutions, deletions

Art Unit: 1646

or insertions to make to achieve any desired property. Applicant has not defined a difference in structure or difference in function between the protein corresponding to SEQ ID NO: 2 and variants of said protein. If a variant of the protein corresponding to SEQ ID NO: 2 is to have a structure and function similar to the protein corresponding to SEQ ID NO: 2, then the specification has failed to teach one of skill in the art which amino acid substitutions, deletions or insertions to make that will preserve the structure and function of the protein corresponding to SEQ ID NO: 2. Conversely, if a protein variant of SEQ ID NO: 2 need not have a disclosed property, the specification has failed to teach how to use such a variant or to use a chemical that binds to it, as identified by the claimed method.

The problem of predicting protein structure from sequence data and in turn utilizing predicted structural determinations to ascertain functional aspects of the protein is extremely complex. While it is known that many amino acid substitutions are generally possible in any given protein, the positions within the protein's sequence where such amino acid substitutions can be made with a reasonable expectation of success are limited. Certain positions in the sequence are critical to the protein's structure/function relationship, e.g. such as various sites or regions directly involved in binding, activity and in providing the correct three-dimensional spatial orientation of binding and active sites. These regions can tolerate only relatively conservative substitutions or no substitutions (see Bowie et al., 1990, Science 247:1306-1310, especially p.1306, column 2, paragraph 2). However, Applicant has provided little or no guidance beyond the mere presentation of sequence data to enable one of ordinary skill in the art

Art Unit: 1646

to determine, without undue experimentation, the positions in the protein which are tolerant to change (e.g. such as by amino acid substitutions or deletions), and the nature and extent of changes that can be made in these positions. Also, these or other regions may be critical determinants of antigenicity. It is well appreciated in the art of antibody production that it is unpredictable which amino acids are critical antigenic determinants (see Alexander et al., Proc. Natl. Acad. Sci. 89(3352-3356)1992. Protein antigenicity can be significantly reduced by substitution of even a single residue. Further, even if an amino acid substitution does not destroy the activity of the immunizing protein, the substitution may significantly reduce the antigenicity of the protein (see the Abstract of Alexander et al.). The specification does not provide sufficient guidance as to how to make antibodies or other binding partners that are specific to variants of SEQ ID NO: 2 that can be used for any specific purpose.

Although the specification outlines art-recognized procedures for producing variants (e.g. pages 3-4), this is not adequate guidance as to the nature of active variants that may be constructed, but is merely an invitation to the artisan to use the current invention as a starting point for further experimentation. Even if an active or binding site were identified in the specification, they may not be sufficient, as the ordinary artisan would immediately recognize that an active or binding site must assume the proper three-dimensional configuration to be active, which conformation is dependent upon surrounding residues; therefore substitution of non-essential residues can often destroy activity.

Art Unit: 1646

Therefore, due to the large quantity of experimentation necessary to generate the essentially infinite number of variants recited in the claims and to screen same for activity, the lack of direction/guidance presented in the specification regarding which structural features are required in order to provide activity, the absence of working examples directed to same, the complex nature of the invention, the state of the prior art which establishes the unpredictability of the effects of mutation on protein structure and function, and the breadth of the claims which fail to recite any particular structural or functional limitations, undue experimentation would be required of the skilled artisan to make and use the claimed invention in its full scope.

Conclusion

No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brannock, Ph.D., whose telephone number is (703) 306-5876. The examiner can normally be reached on Mondays through Thursdays from 8:00 a.m. to 5:30 p.m. The examiner can also normally be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.


Application/Control Number: 09715962

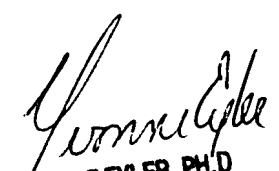
Page 8

Art Unit: 1646

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

MB


June 28, 2002


YVONNE EYLER, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600